

**REMARKS**

Applicants thank the Examiner for the courtesies extended to Applicants' representative during the interview on August 19, 2008. During that interview, the rejections contained in the Final Office Action mailed on June 19, 2008, were discussed. The substance of the interview is incorporated into this response.

In the Final Office Action,<sup>1</sup> the Examiner rejected claims 1-11 and 25-27 under 35 U.S.C. § 101; rejected claims 1, 4, 10, 11, 13, 16, 22, 23, and 25-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0128230 by Oppenheimer et al. ("Oppenheimer") in view of U.S. Patent No. 6,336,103 to Baker ("Baker"); and objected to claims 2, 3, 5-9, 14, 15, and 17-21 as being dependent upon a rejected base claim, but otherwise allowable. Applicants thank the Examiner for the indication of allowable subject matter.

Applicants amend claims 1, 2, 10, 13-23, and 25. Claims 1-11, 13-22, and 25-27 remain pending and under examination.

**I. Rejection Under 101**

Applicants respectfully traverse the rejection of claims 1-11 and 25-27 under § 101, at least because claims 1-11 and 25-27 fully comply with the requirements of § 101. Nevertheless, in an effort to expedite prosecution, and as agreed with the Examiner during the interview, Applicants amend independent claims 1, 10, and 25 to obviate the rejection. Applicants therefore respectfully request the Examiner to withdraw the rejection of claims 1-11 and 25-27 under § 101.

---

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of certain art and claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

## II. Rejection Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 4, 10, 11, 13, 16, 22, 23, and 25-27 under 35 U.S.C. § 103(a) as being unpatentable over Oppenheimer in view of Baker. A *prima facie* case of obviousness has not been established at least because the differences between the prior art and Applicants' claims are such that it would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the prior art to arrive at Applicants' claimed invention.

Neither Oppenheimer nor Baker, taken individually or in combination, teaches or suggests each and every element of Applicants' claims. Claim 1 calls for a method of structuring a performance-based participation certificate contract, comprising the steps of identifying a pool of assets; identifying parameters for the assets; establishing a base guarantee fee for a security; identifying a manner of securing the base guarantee fee for the contract; issuing the security reflecting the parameters of the assets; determining, using a computer, performance of the assets using a performance index; calculating, using the computer after issuing the security, a second guarantee fee based on the determined performance of the assets and based on the base guarantee fee; resetting the base guarantee fee for the security with the second guarantee fee, based on realized performance of the assets, once every predetermined time period. Oppenheimer and Baker fail to teach or suggest the combination of features recited in claim 1.

As discussed during the interview, Oppenheimer discloses that a price adjustment may be made at the time of delivering loans compared to an initial price established at the time of making a cash commitment. (Oppenheimer, paragraph

0052). Oppenheimer is completely silent as to any adjustment of a guarantee fee “after issuing the security,” as required by claim 1. Moreover, Oppenheimer does not teach or suggest determining performance of assets after issuing the security and “calculating, using the computer after issuing the security, a second guarantee fee based on the determined performance of the assets and based on the base guarantee fee,” as required by claim 1 (emphasis added). Indeed, Oppenheimer is silent on using a “price index” to determine performance.

Baker fails to cure the deficiencies of Oppenheimer. The Examiner alleges that Baker discloses “a performance index.” (Final Office Action at 4). However, Baker is unrelated to “guarantee fees,” as required by claim 1. Baker does not teach or suggest establishing a base guarantee fee and “calculating, using the computer after issuing the security, a second guarantee fee based on the determined performance of the assets and based on the base guarantee fee,” as required by claim 1. Baker simply discloses that pension plan liabilities can be correlated to indexes, such as an inflation index, to ensure that future payouts can be made. Baker, 3:56-4:1. Baker never “reset[s] the base guarantee fee for the security with the second guarantee fee, based on realized performance of the assets, once every predetermined time period,” as required by claim 1.

Independent claims 13 and 25, although of different scope than claim 1, patentably distinguish from Oppenheimer and Baker for at least the same reasons as claim 1.

Regarding claims 10 and 22, the Examiner previously rejected these claims under § 112, making them allowable over the prior art if rewritten in independent form.

(Office Action mailed February 14, 2008). Applicants amended claims 10 and 22 into independent form in the Reply filed April 28, 2008 to include elements similar to those recited by claims 1 and 13 and to overcome the rejection under § 112. Accordingly, Applicants respectfully submit that claims 10 and 22 patentably distinguish from Oppenheimer and Baker for at least the reasons discussed above.

Moreover, neither Oppenheimer nor Baker teaches or suggests “securing one or more future guarantee fee increases” by “at least one of a group consisting of: varying an interest payment to a security holder as a guarantee fee varies . . . ; retaining an excess servicing strip . . . ; and securing future guarantee fees with a corporate guarantee,” as required by claims 10 and 22. Further, neither Oppenheimer nor Baker teaches or suggests securing one or more future guarantee fees using any of the claimed techniques “after issuing the security,” as required by claims 10 and 22.

Because neither Oppenheimer nor Baker, taken individually or in combination, teaches or suggests each and every element required by claims 1, 4, 10, 11, 13, 16, 22, 23, and 25-27, the scope and content of the prior art, as well as the differences between the prior art and the claimed invention, have not been properly ascertained (M.P.E.P. § 2141), and no *prima facie* case of obviousness has been established for these claims. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection under § 103(a).

### **III. Conclusion**

As discussed during the interview, the claims, as amended, now “further distinguish . . . from the prior art.” (Interview Summary dated August 19, 2008). Applicants therefore request the timely issuance of a Notice of Allowance. Should the


Examiner deem it necessary, Applicants respectfully request that any formal matters be handled with an Examiner's Amendment by contacting Applicants' representative.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 18, 2008

By:   
Nathan A. Sloan  
Reg. No. 56,249  
404.653.6464